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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/454,868	12/03/1999	BARRY S. BROWN	DM-7029	4342

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EXAMINER

GUCKER, STEPHEN

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 03/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/454,868

Applicant(s)

Brown et al.

Examiner

Stephen Gucker

Group Art Unit

1647

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 12/4/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-24 is/are pending in the application.
- Of the above claim(s) 1-22 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 23-24 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5
- ☒ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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DETAILED ACTION

1. Applicant's election with traverse of Group II, claims 23-24, in Paper No. 11 is acknowledged. The traversal is on the grounds that the search for art poses no undue burden on the Examiner, since the search for art for the Group II claims would include a search for art for the assay of the Group I claims. This is not found persuasive because the search for art for the elected claims for methods of treatment is non-overlapping and distinct for the search for art for the assay claims of Group I and would pose a serious search burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 11.

3. If applicant desires priority under 35 U.S.C. 119(e) based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph.

4. The disclosure is objected to because of the following informalities:

The "Brief Description of the Figures" section of the instant application is missing its heading and the description for Figures 1-4 must include a description for each of the individual panels found in the figures.

Appropriate correction is required.

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5. Claims 23-24 are objected to as being dependent upon a non-elected claim (claim 1).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Earl et al. (U.S. Patent No. 5,173,489; "Earl"). Earl discloses linopirdine (3,3-bis(4-pyridinylmethyl)-1-phenylindolin-2-one) (column 61, line 5 to column 62, line 68) and methods of treating neurological or neurodegenerative disorders such as Alzheimer's disease (column 1, lines 16-51; column 2, line 66 to column 3, line 35) by administering linopirdine. The use of linopirdine has the inherent property of acting as an antagonist to KCNQ2/KCNQ3 channels as taught by the instant disclosure and meets all the limitations of claims 1 and 23 because the use of linopirdine would inherently meet the assay limitations of claim 1 as taught by the instant disclosure.

8. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Dailey et al. ("Dailey") in light of Rundfeldt et al. ("Rundfeldt"). Dailey discloses methods of treating epilepsy-prone rats with (N[2-amino-4-(4-fluorobenzylamino)-phenyl]carbamic acid ethyl ester dihydrochloride), otherwise known as the anticonvulsant retigabine (abstract of Dailey and see page 73 of Rundfeldt). Retigabine has the inherent property of acting as an agonist to KCNQ2/KCNQ3 channels as shown by Rundfeldt (abstract). Retigabine meets all the limitations of claims 1 and 24 because the use of retigabine would inherently meet the assay limitations of

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claim 1 as taught by Rundfeldt. Note that Rundfeldt need not be prior art as the reference is only being used to prove that retigabine has the inherent property of modulating KCNQ2/KCNQ3 channels.

9. No claim is allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (703) 308-6571. The examiner can normally be reached on Monday to Friday from 0930 to 1800. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is currently (703) 308-4242, but Applicant should confirm this by phoning the Examiner before faxing.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

SG

Stephen Gucker

February 24, 2003

Gary d. Kunz
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